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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,369	12/19/2001	Hideaki Ito	740819-715	4540

7590 06/17/2004

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,369

Applicant(s)

ITO ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8: Examiner could find no explicit nor implicit support for step b) of claim 8; specifically, successively heating while reducing the pressure. Moreover, the specification seems to teach away from such a step. For example, page 10 of the specification discusses that there is an optimum level for the reduction. If the pressure is being reduced during the heating, then the pressure will not be at the optimal level during the process – at best it could be at the optimal level for only a portion of the process. The above is deemed to establish a prima facie showing of failure to describe the invention. The burden is now on applicant to demonstrate that the invention was described in the specification as originally filed.

Examiner considered page 14, lines 4-5 which states "...the pressure in the glass pipe is reduced while the glass pipe and the rod are heated...." If one of ordinary skill

Art Unit: 1731

were reading that line in a vacuum, it is possible he would conclude that such is support for the step b) of claim 8. However, the standard is to look at the specification as a whole. Reading the specification as a whole it is clear that one would interpret the above passage as: the pressure in the glass pipe is in a reduced state while the glass pipe and rod are heated. To support this conclusion: 1) the specification is directed to finding an optimal pressure level, 2) there is no mention of any specific (or non specific) rate of reduction, any starting/ending point/condition, or the like, and 3) the sentence spanning pages 24-25 indicates that figure 4 is directed to "altering the pressure reduction level" but the alteration shown regarding pressure is from working example to working example; the alteration does NOT occur during any individual example process.

Claim 11: Examiner could find no support for step b) – specifically the feeding "while reducing the pressure". This is substantially the same reason why claim 8 lacks support.

There is no support for the various steps being done "successively". Examiner could not find any explicit or implicit support for such. Also see rejection under 35 USC 112 – 2nd paragraph. Furthermore, as can be seen from the drawings, the rod and the pipe are heated simultaneously, not successively.

Examiner could find no support for the step d) being done after step c) for either claims 8 or 11. As can be seen from the drawings, the steps c) and d) are done substantially simultaneously.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The usage of “and/or” makes the claims confusing as to what is required – especially when followed closely by another “or” (...pipe and/or the first glass rod or the second glass rod...”

It is not understood what is meant by “successively” as used throughout the claims. First it is noted that the specification does not mention this at all. Claims are interpreted in light of the specification, so when something is not even mention in the specification it is impossible to rely on the specification to determine what is meant. Furthermore, it appears that all regularly accepted definitions do not comport to what is disclosed in the present invention. Regular usage are along the lines of: following each other without interruption; all definitions relate to having a sequence/plurality of people, objects, steps, etc. Presently, with only one preform being heated (step d) there is nothing for it to be in succession with. Example: Step c) there is only one pipe – thus it can't be in succession with anything.

Claim 8, step d) there is no antecedent basis for “the preform” or “the outer diameter”. The last three lines of claim 8 refer to “after” the pipe/rod(s) being formed into a tapered shape. However there is no mention of anything being formed into a

Art Unit: 1731

tapered shape. It is unclear if such requires the creation of a tapered shape, or if it is to be interpreted as a conditional statement: "if a tapered shape is created, then...."

Claims 9-10 refer to conditions during step d). Step d) occurs "after the step c)". Step c) is the collapse of the pipe. Claims 9 and 10 use variables which refer to positions "at which the glass pipe is caused to collapse". However, the pipe was collapsed prior to step d). So there is no collapsing in step d). Since there is no collapsing during step d), there is no L1 or L2 during step d). It is not understood how step d) could be performed at $0.1 < L1/(L1+L2) < 0.8$. When there is no L1 or L2 during step d). Similarly for claim 10: there is neither D1 nor d1 during step d).

There is confusing antecedent basis for "the core" of claims 8 and 11. Such suggests that there must be a "first glass rod for a core". It is unclear if that was the intended meaning.

Claim 11 step d): there is no antecedent basis for "the preform" or "the outer diameter."

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no mention of the "successively" feeding, the collapse "successively" or the "successively" elongating. There is no mention of such things in the specification – since claims are to be interpreted in light of the

Art Unit: 1731

specification, the various limitations must be described in the specification so that one can look to the specification to determine what is meant by the claims.

Response to Arguments

Applicant's arguments with respect to claims 8-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

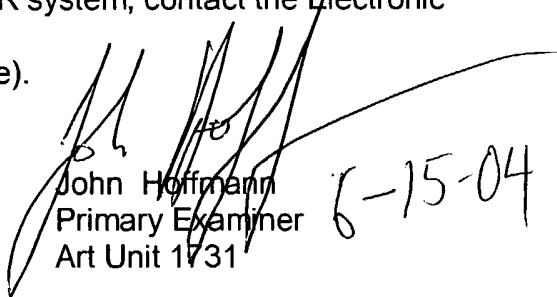
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

6-15-04

jmh